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EXAMINER

WELLS, LAUREN Q

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 10/16/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/846,270

Applicant(s)

PUSHPANGADAN ET AL.

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) 31,36,38,40-42 and 48-70 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 and 45-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other: _____

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DETAILED ACTION

Claims 1-70 are pending. Claims 31, 36, ^{38 & 40 ✓} 28, 40-42 and 48-70 are withdrawn from consideration, as they are directed to non-elected subject matter.

Election/Restrictions

Applicant's election of a composition comprising macrotomia, ocinum, jasminum, cymbopogen, and a carrier in Paper No. 8 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). This requirement is hereby made final.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-30, 32-35, 37, 39, 43-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) The terms "safe", "health protective", and "beautifying" in claim 1 (line 1) is a relative term which renders the claim indefinite. The term "safe" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

(ii) The term "ecofriendly" in claim 1 (line 1) is vague and indefinite, as the meaning of this term is unknown.

(iii) The phrase "providing special properties" in claim 1 (line 3) is vague and indefinite,

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as the phrase is relative and it is not clear what compounds are distinguished by such a phrase.

Do not all compounds provide special properties?

(iv) Claims 2-9, 11-12, 14-19, 29, 34 are rejected because the compound in these claims is not defined with any chemical or physical characteristic, but only by functional properties. A claim to a material defined solely in terms of what it can do, or a property thereof, does not particularly point out the claimed invention. Thus, the scope is indefinite. See *ex parte Pulvari* (POBA 1966) 157 USPQ 169. In regard to claim 2, what are the additives? Are they extracts of these plants or are they something else? In regard to claim 6, what are the colorants? Are they extracts of these plants or are they something else?

(v) Claims 3-4 recite the limitation "the essential oil/aroma isolates" in lines 1. There is insufficient antecedent basis for this limitation in the claim.

(vi) Claim 3 is vague and indefinite, as it is confusing. Why are some isolates referred to in the plural and some referred to in the singular? Anti-microbial what?

(vii) Claim 7 is vague and indefinite, as it is confusing. What does the following refer to or mean: "and the quantum of the essential oils used base on the part from which the essential oil is extracted"?

(viii) Claim 8 is vague and indefinite, as it is not clear to what the percent weights refer. 30-100% of what?

(ix) Claim 9 is vague and indefinite, as it is not clear to what the percent weights refer. 0.1-10 of what?

(x) A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting

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claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 11 recites the broad recitation "leucoderma", and the claim also recites "more particularly of lips" which is the narrower statement of the range/limitation.

(xi) The term "lipophilic properties" in claim 12 is a relative term which renders the claim indefinite. The term "lipophilic properties" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

(xii) The terms "purplish", "dark", "deep", "blackish", "pastel" in claim 14 is a relative term which renders the claim indefinite. The terms "purplish", "dark", "deep", "blackish", "pastel" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

(xiii) Claims 15-19 recite the limitation "red color" in line 1. There is insufficient antecedent basis for this limitation in the claim.

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(xiv) Claim 17 is vague and indefinite, as it is not clear to what the percent weights refer. 1-20% of what?

(xv) Claims 20-24 provide for the use of the composition of claim 1, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 20-24 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

(xvi) Claim 25 recites the limitation "essential" in line 1. There is insufficient antecedent basis for this limitation in the claim.

(xvii) Claim 26 recites the limitation "softening agent" in claim 1. There is insufficient antecedent basis for this limitation in the claim.

(xviii) Claim 27 recites the limitation "lusture producing agent" in line 1. There is insufficient antecedent basis for this limitation in the claim.

(xix) Claim 28 is vague and indefinite, as it is not clear to what the percent weight refers. 0.5-2% of what?

(xx) Claim 28 recites the limitation "skin protecting agents" in line 1. There is insufficient antecedent basis for this limitation in the claim.

(xxi) Claim 28 is vague and indefinite, as it is not clear to what the percent weight refers.

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0.0001-0.09% of what?

(xxii) Claims 29, 35, 37, 29-41 recites the limitation "essential oil" in line 1. There is insufficient antecedent basis for this limitation in the claim.

(xxiii) Claim 29 is vague and indefinite, as it is not clear to what the percent weight refers. 0.0001-0.009% of what?

(xxiv) Claim 29 is further vague and indefinite, as it is confusing. To what does "functional attributes" refer? What does this term mean?

(xxv) Claim 30 is vague and indefinite, as it is confusing. Is beeswax the base material?

(xxvi) Claim 32 recites the limitation "extracted organic compound" in line 2. There is insufficient antecedent basis for this limitation in the claim.

(xxvii) Claim 32 provides for the use of extracted organic compounds, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 32 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

(xxviii) The term "improved" in claim 33 (line 1) is a relative term which renders the claim indefinite. The term "improved" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would

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not be reasonably apprised of the scope of the invention.

(xxix) Claims 35, 37, and 39-41 are vague and indefinite, as they are confusing. How can properties be selected from essential oils?

(xxx) Claims 34, 27, 39-42 are vague and indefinite, as a claim must begin with a capital letter and end with a period. The reference claims have no periods.

(xxxi) Claims 43-46 recite the limitation "aroma isolate" in line 2. There is insufficient antecedent basis for this limitation in the claim.

(xxxii) Claim 43 is vague and indefinite, as it is confusing. To what is the ratio referring?

(xxxiii) Claim 47 recites the limitation "fixative" in line 1. There is insufficient antecedent basis for this limitation in the claim.

(xxxiv) Claim 47 is vague and indefinite, as the language is confusing and it is not clear what it being stated.

This application is replete with 35 U.S.C. 112 issues. The above are just some examples. Applicant is required to review all of the claims for 35 U.S.C. 112 issues and make appropriate corrections.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-30, 32-35, 37, 39, 43-47 are rejected under 35 U.S.C. 103(a) as being

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unpatentable over Schultz (2002/0082279) in view of Tu (CN 1113773) in further view of Benford (5110593).

Schultz teaches a composition for the treatment of dermatologic diseases comprising an active agent, essential oils, and a carrier. The composition is disclosed as treating acne, dermatitis, wrinkles and other disorders. Citronella (synonym for cymbopogon nardus), basil (synonym for ocimum basilicum), and jasmine are disclosed as essential oils with direct skin effects for use in his composition. See [0003]-[0019]. The reference lacks macrotomia and beeswax.

Tu teaches a cosmetic composition comprising natural plant extracts for the treatment of acne, folliculitis, dermatitis, and wrinkles. Arnebia (synonym for Macrotomia) is disclosed as a plant extract. See abstract.

Benford teaches a composition for treating dermatitis. Beeswax is disclosed as the carrier. See abstract.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the active agent of Schultz as the arnebia of Tu because a) Schultz and Tu are both directed to topical cosmetic composition for treating wrinkles, dermatitis, and acne; b) Schultz teaches that the active ingredient can be a dermatologic active ingredient in the form of a non-prescription drug, and Tu teaches arenbia as a dermatologic active agent.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the carrier of the combined references as beeswax because the combined references teach a composition for treating dermatitis and Benford teaches beeswax as a carrier for use in topical compositions for treatment of dermatitis.

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Notes/Comments

The Examiner respectfully points out a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russell S. Travers can be reached on (703)308-4603. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw
August 30, 2002


DAMERON L. JONES
PRIMARY EXAMINER